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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,615	11/27/2000	Jack Cheng	GRQ-00100	8414

28960 7590 08/22/2003
HAVERSTOCK & OWENS LLP
162 NORTH WOLFE ROAD
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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,615

Applicant(s)

CHENG ET AL.

Examiner

Lan Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/3/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 and 132-144 is/are pending in the application.
- 4a) Of the above claim(s) 5-13, 15, 18-53 and 132-142 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 14, 16, 17, 143 and 144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's argument about the election of Sub-Species II(A-J)2 which includes Figures 7A, 7B, 8A-8F, 9A, 9B, 10 and 15A-15C has been considered. It is reminded that in Office Action dated 7/12/02, paragraph #2 from page 2 and continues onto page 3, Applicant elected over the phone of a sub-species IIA2 which corresponds to figure 7A pertaining to a method of controlling with the aid in minimizing bonding by using a coating of a thin film.

Information Disclosure Statement

2. The two documents submitted with the Information Disclosure Statement filed 7/3/3 have been considered. The Examiner maintains that Massa does not disclose an air cushion. Kutomi states "When an impactor gives impacts in horizontal direction and sustains the vibration in resonance, vertical vibrations are also induced through the Poasson's ratio." This statement does not describe nor define an air cushion. Kutomi further states in his Conclusions "1. Real contact areas are vibrated mainly in the same direction as the impacts direction. The movement in the direction perpendicular to the impacts does not affect on the friction coefficient." In other words, there is some vertical displacement but said vertical displacement does not affect the friction coefficient.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 14, 143 and 144 are rejected under 35 U.S.C. 102(b) as being anticipated by Massa.

Re: claims 1, 2, 143 and 144, Massa shows a method of controlling an effective coefficient of friction between a first surface of a first element 1 and a second surface of a second element 2, as in the present invention, the method comprising the steps of: configuring the first and second surfaces to be in slidable contact with one another along an interface between the first surface and the second surface and under a force sufficient to maintain contact and having a static friction therebetween, as shown in figure 1; inducing a repetitive and symmetrical motion in the first surface parallel to the interface thereby altering the effective coefficient of friction, see column 1, lines 66-69. Note that the language of claim 143 does not exclude the interface to be at the anti-nodal region and at areas surrounding the anti-nodal region. Re: claim 144, note that static friction force as understood is the friction force exists while the objects are stationary. Massa induces motion and working with kinetic friction force existing between two surfaces the same as in the present invention. Hence, the static friction force would not be altered.

Re: claim 3, the first element 1 comprises a set of dimensions, a desired dimension of the first element is being varied in response to an electronic signal wherein element 1 is oscillated in response to electronic signal from sources 6 and 9.

Re: claim 4, Massa further provides a transducer 3, wherein said transducer converts the electronic signal into microscopic mechanical displacements to generate the symmetrical motion, see from column 2, line 67 to column 3, line 2.

Re: claim 14, see column 3, lines 1 and 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Massa in view of Kamigaito et al.

Re: claim 16, Massa's method of controlling, as discussed in the rejection of claims 2 and 14, lacks a step of further reducing the frictional force by adding a thin film to at least one of the surfaces. Kamigaito teaches the concept of adding a thin film 2 to the surface of element 3 in figure 6 in order to reduce the frictional force between element 3 and element 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Massa's method of controlling with

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a step of adding a thin film to at least one of the surfaces to further reducing the frictional force between two elements as taught by Kamigaito.

Re: claim 17, Kamigaito further teaches the concept of ion implantation in the thin film in order to enhance the wear resistance between the two sliding elements in column 3, lines 25-42. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Massa's method to include a step of implanting ions in the thin film in order to enhance wear resistance between two sliding elements as taught by Kamigaito.

Response to Arguments

7. Applicant's arguments filed 7/3/3 pertaining to the claims have been considered but are moot because Applicant did not request to enter the Amendment dated 4/10/03.

Conclusion

8. This is a continuation (RCE) of applicant's earlier Application No. 09/723,615. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is 703-308-8347. The examiner can normally be reached on M-F, 8 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4177.

XLN

XLN
August 13, 2003


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600